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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,476	02/08/2002	Ichiro Hamada	SONYJP 3.0-210	9957

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/976,476	Applicant(s) HAMADA, ICHIRO	
	Examiner Matthew Heneghan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/3/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 March 2006 has been entered.

2. In response to the previous office action, Applicant has amended claims 1, 3, 4, 6, 7, and 9 have been amended and claims 2, 5, 8, and 10-12 have been cancelled. Claims 1, 3, 4, 6, 7, and 9 have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed 3 March 2006 has been fully considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 3, 4, 6, 7, and 9 are rejected under 35 U.S.C. 101 because the claimed invention the claimed invention is directed to non-statutory subject matter.

Regarding claims 1, 4, and 7, though the claimed invention clearly yields a tangible result in the situation wherein either of the conditions listed in the final limitation of each claim is fulfilled, these claims also teach to a condition wherein neither condition is fulfilled. In this situation, the claimed invention lacks a tangible result. Since the claim encompasses an invention that lacks a result that is useful, concrete, and tangible, the claim is non-statutory.

Claims 3, 6, and 9 depend from rejected claims 1, 4, and 7, and include all the limitations of those respective claims, thereby rendering those dependent claims as non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,199,069 to Barrett et al. (hereinafter "Barrett") and U.S. Patent No. 4,197,502 to Sumner et al. (hereinafter "Sumner").

NOTE: Barrett fully incorporates Sumner by reference (see Barrett, column 1, lines 55-57).

As per claims 1 and 4, Barrett an improvement of a radio device which discloses an input device operable to receive data and a decoder that is operable to decode the received data when said data is encrypted data (see Barrett, column 1, line 39-41). Barrett discloses the necessity of judging for proper decoding of encrypted data (see Barrett, column 1, lines 50-57), citing Sumner. The incorporated invention of Sumner further also judges whether the data is audio data (see Sumner, column 3, lines 30-34). The failed judging of the audio test or the encrypted decoding tests leads to the muting of the signal (see Barrett, lines 57-59).

As per claims 3 and 6, Sumner further discloses the use of a counter that is used to count the number of successful judgments, and does not transition out of the "bad window" (i.e. not audio and/or not properly decoded) state until a number of "good" judgments have been detected (see Sumner, column 4, lines 24-55). The number of periodic counts necessary before the instantiation of such a transition constitutes a "predetermined time."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,199,069 to Barrett et al. (hereinafter "Barrett") and U.S. Patent No. 4,197,502 to Sumner et al. (hereinafter "Sumner").

All of the limitations of claims 7 and 9 are anticipated by Barrett and Sumner, as described above; however, the invention of Barrett and Sumner is disclosed as an implementation using hardware gates and registers, and is therefore not embodied as a computer-readable program, as per the preamble of claim 7. It is not clear as to whether or not this preamble carries any patentable weight in these claims. If it does not, then the claims are anticipated; otherwise, it is the case that Barrett and Sumner are not embodied on a computer-readable program.

Official notice is given that it is well-known in the art to implement configurations implemented in hardware using a computer-readable program implemented on a microprocessor, FPGA, or ASIC, in order to allow a user to maintain the device by introducing new hardware configurations.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the gates and registers of the invention of Barrett

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and Sumner by using a configuration on a computer-readable program, as is well-known in the art, in order to allow a user to maintain the device by introducing new hardware configurations.

Response to Arguments

7. Applicant's arguments, see Remarks, filed 3 March 2006, with respect to the rejections of claims 1, 3, 4, 6, 7, and 9 under 35 U.S.C. 102 and 35 U.S.C. 103 have been fully considered and are persuasive in view of Applicant's amendments. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the art cited above.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques, can be reached at (571) 272-6962.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

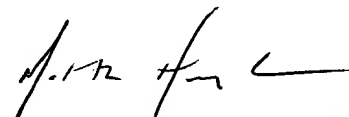
Or faxed to:
(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH

May 17, 2006

A handwritten signature in black ink, appearing to read 'M. Heneghan', with a stylized flourish at the end.

Matthew Heneghan, USPTO Art Unit 2134